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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,624	03/18/2004	Gabriela Chiosis	64987-A/JPW/GJG/CMR	2155

7590 11/05/2004
John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

LEE, SUSANNAH E

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/805,624	CHIOSIS ET AL.	
	Examiner	Art Unit	
	Susannah Lee	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-89 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 83-89 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-82 have been canceled and Claims 83-89 have been amended by a preliminary amendment filed on 03/18/2004. Therefore, Claims 83-89 are pending in the instant application.

Information Disclosure Statement

Applicant's information disclosure statement (IDS), filed on 03/18/2004 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Priority

This application is a continuation of prior Application No. 09/938,746, filed on 08/23/2001, which resulted in a patent being issued on 05/11/2004. This application names an inventor or inventors named in the prior application.

Specification

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

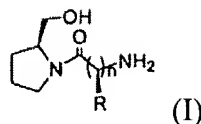
Complete revision of the content of the abstract is required on a separate sheet. See MPEP § 608.01(b). In the instant application, the abstract of the disclosure is objected to because it does not disclose the general nature of the compound or composition, rather it only discloses a method of use for the compound, that is a method for re-sensitizing vancomycin resistant Gram-positive bacteria.

In the instant case, a proper abstract could read as follows:

A. The present invention relates to pyrrolidine compounds, etc...; or

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B. Compound represented by formula (I):



Wherein all symbols represent the same meanings as described in specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 84-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claims are permissible where the dependent claim refers to a valid preceding claim. In the present case, Claims 84 and 85 do not refer to a preceding claim, but depend on a lower claim. Claim 86 does not refer to a preceding claim, but depends on itself. Claims 87 to 89 do not depend on a valid independent or dependent claim. Therefore, the claims are rejected and will not be further treated on the merits. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

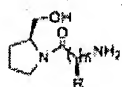
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

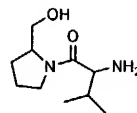
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Claim 83 is rejected under 35 U.S.C. 102(b) as being anticipated by Anderson, Nicholas H., Total synthesis of the antibiotic actinonin, Journal of the Chemical Society, 1974, RN 54124-60-6 (see attached abstract).

Applicant's instant elected invention in Claim 83 teach compounds of formula,



, wherein: n is an integer from 1 to 6 inclusive and R is hydrogen or a C₁ to C₆ straight chain or branched alkyl group.



Anderson teaches pyrrolidine compounds of formula, , wherein: n is 1 and R is C₃ branched alkyl (isopropyl) group.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

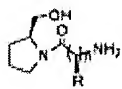
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson.

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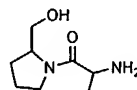
Applicants instant elected invention in Claim 83 teaches the compound of formula,



, depicted in Claim 83, wherein: n is an integer from 1 to 6 inclusive and R is

hydrogen or a C₁ to C₆ straight chain or branched alkyl group.

Determination of the scope and content of the prior art (MPEP § 2141.01)



Anderson teaches pyrrolidine compounds of formula, , wherein n is 1 and R is

a branched alkyl (isopropyl) group.

Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)

The difference between the prior art of Anderson and the claims is that in the instant application n is an integer from 1 to 6 inclusive and R is hydrogen or a C₁ to C₆ straight chain or branched alkyl group, while in Anderson n is 1 and R is a branched alkyl group.

Finding of prima facie obviousness – rationale and motivation (MPEP § 2142-2413)

One skilled in the art would have found the claimed compound prima facie obvious because it is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lahr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (i.e. pharmacological use). In the instant application, substituting n from 1 to 1 to 6 and R from a branched alkyl group to a hydrogen or a C₁ to C₆ straight chain of a known compound is not a patentable modification absent unexpected or unobvious results.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Lee whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susannah Lee
Patent Examiner, AU 1626

for Kamal Saeed
Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

Date: 11/02/04